

ELECTRONIC FILING

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Thomas Heering	Confirmation No.: 9176
Serial No.: 09/856,537	Art Unit: 3692
Filed: September 7, 2001	Examiner: Jennifer L. Liversedge
For: METHOD FOR BILLING SERVICES WHICH CAN BE RETRIEVED FROM THE INTERNET	Attorney Docket No: 11829-003-999

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby requests review of the Final Rejection mailed October 3, 2007 ("Final Rejection") of the above-captioned application prior to filing an appeal brief for the reasons set forth below. No amendments are being filed with this request. A Petition for Extension of Time and a Notice of Appeal are filed herewith.

I. INTRODUCTION

Claims 1, 3 and 6-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0 756 068 A2 (Ronen). Applicant respectfully traverses these rejections.

Briefly, the present application discloses and claims a method of billing a fee for a service by means of a "chargeable" connection (e.g. a premium rate or 900-type connection) in which a direct dial number (better known in North American telephone terminology as a Direct Inward Dialing (DID) number) is used as an order code, e.g. to associate the particular call with the particular order.

Ronen is also directed to methods for using 900-type telephone connections to

accomplish billing for services, in particular for services delivered over the Internet. However, Ronen contains no disclosure or suggestion for using direct dial numbers (DID numbers) as order codes. Rather, Ronen uses one of two other tools of the telephony trade to associate a call with a particular user: 1) Automatic Number Identification (ANI) or 2) touch-tone input.

II. FAILURE TO ESTABLISH A *PRIMA FACIE* CASE OF OBVIOUSNESS

With respect to rejections of patent claims under 35 U.S.C. § 103(a) as obvious, the Supreme Court has affirmed that it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR Int’l Co v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007). Thus, consistent with the principles enunciated in *KSR*, a *prima facie* case of obviousness can be established by showing a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference *and* to carry out the modification with a reasonable expectation of success, viewed in light of the prior art. Both the suggestion and the reasonable expectation of success must *not* be based on the applicant’s disclosure. *See In re Dow Chemical Co.*, 837 F.2d 469 (Fed. Cir. 1988).

With regard to the final point, the Supreme Court in *KSR* citing *Graham v. John Deere Co.*, 383 U.S. 1 (1966), upheld the principle of *avoiding hindsight bias* and cautioned courts to *guard against reading into the prior art the teachings of the invention in issue*. *KSR*, 127 S. Ct. at 1742:

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. *See Graham*, 383 U.S., at 36, 86 S.Ct. 684 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight” (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (C.A.6 1964))).

Thus, the principles set forth in *Graham* and in *Dow Chemical* – which are still good law post-*KSR* – require that *both* the suggestion and the expectation of success must be found

in the prior art, and not from knowledge gained from the applicant's disclosure.

In support of this requirement, the Patent Office's examination guidelines for determining obviousness specify that after resolution of the Graham factual inquiries, the Office personnel must articulate all three of the following findings to explain a conclusion of obviousness:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) a finding that there was reasonable expectation of success; and
- (3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

"Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" 72 Fed. Reg. 57526, 57534 (October 10, 2007) (hereinafter "Section 103(a) Guidelines.")

The *Graham* factual inquiries are: (1) determine the scope and contents of the prior art; (2) ascertain the differences between the prior art and the claims at issue; (3) resolve the level of ordinary skill in the pertinent art; and (4) evaluate any evidence of secondary considerations. *KSR*, 82 U.S.P.Q.2d at 1395 (*citing Graham*, 383 U.S. at 15-17)

The *Graham* factual inquiries begin with an analysis of the scope and content of the prior art, in view of the scope of the claimed invention. *See* USPTO Guidelines at 57527 (*citing Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005)).

Independent claim 1 is reproduced here for convenience:

1. A method of billing a fee for a service via an electronic route, comprising the steps of:
 - a) transmitting a telephone number of a chargeable service telecommunication connection associated with a service provider to a service buyer;
 - b) monitoring a build-up of the telecommunication connection between the provider and the buyer by a line provider;
 - c) billing the fee for a requested service via the service connection; and
 - d) releasing the requested service to the buyer by the service provider,whereby an order code is allocated and transmitted to the service buyer during transmission of the

telephone service number by the service provider, and *wherein the service connection is a direct-dial connection having a direct-dial number which is used as the order code.*

(Emphasis added).

A *prima facie* case of obviousness has not been made with respect to independent claim 1 or its dependent claims 3 and 6-10. The analysis of the Office action is flawed in that it 1) incorrectly states the scope and content of the prior art and 2) fails to identify any teaching, suggestion, or motivation in the prior art or elsewhere to modify the teachings of Ronen in order to obtain the claimed invention.

Regarding the scope and content of the prior art in view of the claimed invention, especially with regard to the feature in the final "wherein" clause of claim 1 emphasized above, the outstanding Office action makes contradictory statements, neither of which are correct. First, at the bottom of page 3, the Office action states: "Ronen discloses wherein the service connection is a direct-dial connection having a direct-dial number that is used as the order code." (*Column-row citations omitted.*) Later in the same paragraph, at the top of page 4, the Office action states: "It would be obvious to one of ordinary skill in the art at the time of the invention to use the direct-dial number as an order code," implying from the invocation of obviousness that perhaps Ronen discloses direct-dial numbers, but not their use as an order code.

Actually, neither of these characterizations of Ronen is correct, as Ronen does not disclose direct-dial numbers at all. Neither of the terms "direct-dial connection" or "direct-dial number" make any appearance in Ronen. As explained above, these terms as used in claim 1 refer specifically to what in North America is more typically called "Direct Inward Dialing," wherein a special trunk connected to a PBX or other customer system is arranged to outpulse (or send via the D channel, in the case of ISDN) the last several digits of the called telephone number toward the customer system, so that, e.g., a particular telephone extension can be selected.¹ In the invention claimed in claim 1, it is these "direct-dial numbers" that are used as order codes.

Additionally, the Office action fails to identify any teaching, suggestion, or motivation in the prior art or elsewhere to modify the teachings of Ronen in order to obtain

¹ Many years ago, the term "direct *distance* dialing" was used to refer to the ability of customers to directly dial telephone numbers without the assistance of an operator. However, today (and at the time of the application) such use was obsolete, as essentially all calls are dialed directly by end users.

the claimed invention, containing only the bald assertion, at the top of page 4, that “[i]t would be obvious to one of ordinary skill in the art at the time of the invention to use the direct-dial number as an order code.” Ronen itself certainly contains no such teaching or suggestion, being to all appearances complete for its intended purpose with its use of ANI, touch-tones, and the Internet (*see, e.g.* Ronen col. 2, line 34-col. 3, line 17), such that one of ordinary skill looking at Ronen would not be motivated to look to direct-dial numbers to allocate calls to orders (*see In re Herschler*, 591 F.2d 693, 702 (CCPA 1979)).

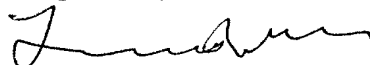
Further, as Ronen repeatedly refers to “the ISP’s 900 telephone number” in the singular (*see e.g.* col. 2, line 8), it teaches away from the direct-dial number-order code feature claimed in claim 1, which obviously results in multiple 900 numbers per service provider (one for each simultaneously usable order code).

III. CONCLUSION

In view of the above, applicants respectfully submit that the present application is in condition for allowance. A favorable disposition to that effect is respectfully requested.

Date: April 2, 2008

Respectfully submitted,



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